

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1 and 3-11 are pending. Claim 2 was previously cancelled. Claim 9 is amended merely to place it in better form, and claims 10 and 11 are added, thereby raising new issues that require further consideration. Claim 1 is independent. The Examiner is respectfully requested to reconsider the rejections in view of the amendments and remarks set forth herein.

Rejection Under 35 U.S.C. § 112, first paragraph

Claims 1 and 3-9 stand rejected under 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed.

In order to overcome this rejection, Applicants have amended claim 1 to remove the alleged new matter contained in this claim in the Reply filed on December 1, 2009.

Applicants respectfully submit that the claims, as amended, are fully supported by and adequately described in the written description of the invention. Accordingly, reconsideration and withdrawal of this rejections under 35 U.S.C. 112 first and second paragraphs are respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claim 1, 3, 4, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Khosravi (U.S. Patent 6,361,546) in view of Brooks et al. (U.S. Patent 6,346,116); and

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Khosravi in view of Brooks et al., and further in view of Rosenbluth (WO 99/56801).

These rejections are respectfully traversed.

Arguments Regarding Independent Claim 1 as Previously Presented

The present invention as currently claimed in claim 1 includes a flexible shaft being a wire member that serves as a guide wire for a balloon catheter and being removably arranged in the lumen of the sheath.

Khosravi discloses a vascular filter 10 which includes an elongate tubular member 12, an expandable frame disposed on the tubular member 12 and a filter material attached to the expandable frame 12 and/or the tubular member 12 (see column 3, lines 59-65). Further, Khosravi discloses a bumper member 54 which is slidably disposed within an elongate tubular sheath 52 and which is advanced by the handles 57, 59 so that the vascular filter 10 is pushed through an outlet 66 of a sheath 52 into a vessel 100 (see column 5, lines 9 to 12 and column 6, lines 6 to 10). As readily seen from the above, when the vascular filter 10 is placed in the vessel, the tubular member 12 is in the vessel while the bumper member 54 is still in the sheath 52, and thus the bumper member 54 and the tubular member 12 function differently, and they are completely discrete members which are independent from each other.

However, the Examiner argues in the Advisory Action that "Member 54 serves as a wire in combination with the tubular member 12 in addition to serving as a bumper before

detaching from the tubular member 12." The Examiner seems to believe that these members correspond to the flexible shaft as the guide wire of the present invention. If these members were a guide wire as the Examiner argues, how they could function as the guide wire? The Applicants respectfully submit that if these members were the guide wire, they must guide some member. Is it possible for them to do so? For example, Khosravi delivers an inflatable balloon 84 or a stent 90 after the vascular filter is pushed into the vessel. Could they serve as the guide wire? The Applicants believe that the answer is "NO" since the tubular member 12 is already located in the vessel, so that it could not deliver any member like a balloon. It should be noted that Khosravi discloses the guide wire 68 separately which may deliver the balloon.

Therefore, what the Examiner argues, especially in the Advisory Action that "Member 54 serves as a wire in combination with the tubular member 12 in addition to serving as bumper before detaching from the tubular member 12", is not reasonable.

The catheter of the present invention does not require the presence of the bumper member, which also makes the present invention distinguished from Khosravi. There is no argument from the Examiner as to why one skilled in the art would easily exclude the bumper member from Khosravi.

Brooks et al. disclose a distal protection device which includes filter assembly of which both ends are fixed to the guide wire 16. The Examiner argues that the filter assembly of Brooks can readily be used in Khosravi. However, the Examiner fails to explain how the

fixed ends of Brooks et al. could result in only one end being fixed with the other end being movable. It should be noted that the argument of the Examiner with reference to column 4, lines 24 to 27 of Khosravi is applicable only to the embodiment of the filter member wherein one end is fixed and the other end is movable. Khosravi never teaches that two fixed end could be changed to one ends being fixed with the other end being movable.

At least for the reasons explained above, Applicants respectfully submit that the combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Khosravi and Brooks et al.

Therefore, independent claim 1 is in condition for allowance.

Dependent Claims

The Examiner will note that dependent claim 9 has been amended to place it in better form, and that dependent claims 10 and 11 have been added to set forth additional novel features of the invention. All dependent claims are in condition for allowance due to their dependency from allowable independent claims, or due to the additional novel features set forth therein.

All pending claims are now in condition for allowance.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are respectfully requested.

CONCLUSION

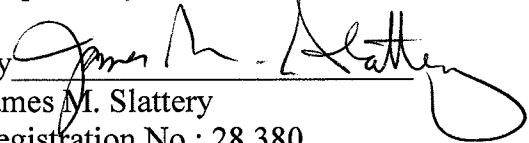
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 208-4030 (direct line).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

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Respectfully submitted,

By 

James M. Slattery
Registration No.: 28,380
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

 JMS/CTT/ctp